APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/100,129	06/19/98	HAVERSTOCK	P	52817.000035

LM01/0705

EXAMINER	
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ART UNIT	PAPER NUMBER
2756	9

DATE MAILED: 07/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

☒ Responsive to communication(s) filed on _Apr 24, 2000_

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire _____ _3_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) _1-33_____ is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) _1-33_____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

  ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

    ☐ received.

    ☐ received in Application No. (Series Code/Serial Number) _____ .

    ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

  *Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Double Patenting

1.   The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Applications as set forth below:

Claims 1-16 of copending Application 09/100,117

Claims 1-19 of copending Application 09/100,118

Claims 1-29 of copending Application 09/100,120

Claims 1-20 of copending Application 09/100,121

Claims 1-28 of copending Application 09/100,128

Claims 1-18 of copending Application 09/100,130

Claims 1-20 of copending Application 09/100,131.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the copending Applications.

This is a _provisional_ obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

2.   following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3.   Claims 1-3, 8-9, 15-17, 19, 21-23 and 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Leone, US Pat. No. 5,745,360.

4.   As to claims 1, 8, 15, and 21, Leone discloses:

a server (fig. 2, WWW server (HTTPD) 8b);

one or more databases, in communication with the server, comprising one or more non-markup language objects (fig. 2, the user requests the server for book 7 stored in a database using a web browser, col. 4 lines 6-45); *and*

a workflow module that facilitates one or more object management tasks, of the server, associated with the one or more non-markup language objects according to a predefined process, wherein the workflow module performs the one or more object management tasks without user input. (Leone discloses a Dynamic Interchange Translation Agent which is extrapolated from CGI scripts for performing predetermined actions to manage workflow without user intervention, col. 3, line 12 – col. 4, line 45).

5.   As to claims 2, 9, 19, and 22, the CGI program locates, opens and converts the non-HTML document based on a user request for the document (col. 4, lines 6-45);

6.   As to claim 3, 10, 16, 17, 23, and 26-33, Leone discloses the a CGI program and a special agent component that distributed, routed and tracked an object according to a predetermined process (col. 4, lines 6-45).

7.   Claims 4-7, 11-14, 18, 20, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leone as applied to claims 1-3, 8-9, 15-17, 19, 21-23 and 26-33 above, and further in view of Schutzman, et al., US Pat. No. 5,627,764 (herein referred to as Schutzman).

8.   As to claims 4, 11, 18, and 24, Leone discloses the invention substantially as claimed.

However, Leone does not specifically disclose *a notifying module that notifies the system user*

that an action is required for the one or more objects.

Schutzman teaches a workflow administration system which provides notification to the

user in the same field of endeavor for the purpose of providing the use feedback for follow-up

activity, workflow administration or routing (Schutzman, col. 3, line 9 – col. 4, line 55).

It would have been obvious to one having ordinary skill in the art at the time the

invention was made to have incorporated the notifying module of Schutzman into the

client/server system of Leone in order to automate the system while maintaining user control and

knowledge of internal functions of the system, thereby increasing system reliability and

efficiency.

9.   As to claims 5, 12, 20, and 25, Leone-Schutzman teaches a translator for translating non-

markup language objects into markup language format (Leone, col. 4, lines 6-45).

10.   As to claims 6 and 13, Leone-Schutzman teaches a client/server system comprising a

HTTP server module (Leone, fig. 2 and col. 4, lines 6-45).

11.   As to claims 7 and 14, Leone-Schutzman teaches a client/server system comprising a

non-markup language server (non-markup language processing functionality resides on server 3;

Leone, col. 4, lines 6-45).

Response to Arguments

12.   **Double Patenting Rejection:** The applicant argued in substance that each related

copending applications claim patentably distinct features such as the non-markup language to

markup language translator (09/100,131), user objects comprising information about a user

(09/100,128), and the workflow module of the instant application (09/100,129). Although the

conflicting claims are not identical, they are not patentably distinct from each other because the

context of the claimed invention is the same as the context of the copending Applications.

13. **Rejection under 35 U.S.C. § 103(a):** Applicant's arguments with respect to claims 1-33

have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this
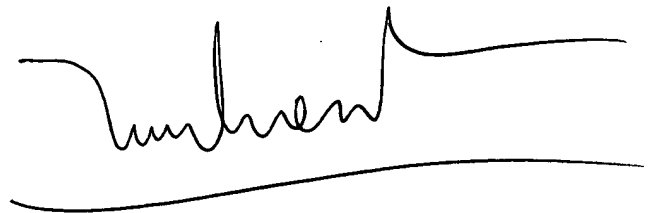
final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The

examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 305-9731 for regular

communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-3900.

Paul H Kang
Examiner
Art Unit 2756

July 1, 2000

**LE HIEN LUU
PRIMARY EXAMINER**